REMARKS/ARGUMENTS

Claim Status

In the prior Office Action,

- Claims 1, 30-20, 22 and 41-48 are allowed (subject to terminal disclaimer);
- Claim 41 was rejected on the ground of nonstatutory obviousness-type double patenting;
- Claims 23-29 were rejected under 35 U.S.C. 112 as being indefinite, but would be allowable if claim 23 was rewritten to recite "the host software file is associated with a…";
- Claims 34-36 would be allows if rewritten so as to not depend on a rejected base claim; and
- Claims 31-33, 37-40, and 49-57 were rejected under 35 U.S.C. 103(a) in light of U.S. Patent 6,256,378 ("Iddulden").

Discussion of Claim Amendments

In response to the above, Applicant has:

1) Amended claim 23, but not in the manner suggested by the Examiner. The remarks provided below explain why the claim is presently patentable.
2) Submitted a terminal disclaimer, so that the term of any issuing patent does not extend beyond the term of U.S. Patent 7,194,756, as well as comply with the other requirements of 37 CFR 3.73(b).
3) Rewritten claims 34-36. This was accomplished by incorporating the limitations of independent claim 31 into claim 34, and amending claims 35 and 36 to depend from claim 34. Applicant submits that claims 34-36 are now allowable, and that the objection be withdrawn.

4) Claims 31-33, 37-40, and 49-57, which were rejected under 35 U.S.C. 103(a), are cancelled.

Discussion of Claim 23

The Office Action has indicated that claims 23-29 would be allowable to overcome the rejection under 35 U.S.C 112, 2nd paragraph, as set forth in the Office Action. Specifically, the claim as previously considered by the examiner and amended herein recites:

> receiving a host software file at a host file database, the host software file for configuring a host wherein the host software file contains messages for interacting with the host on a cable distribution network wherein the host is associated with a specific host manufacturer and a model of the specific host manufacturer.

The Examiner has rejected the claims, stating that the apparent intention was to recite:

> "wherein the host software file is associated with a specific host manufacturer and a model of the specific host manufacturer."

Applicant notes that there are other claims that variously recite:

1) " a ***host*** associated with a specific host manufacturer and a model associated with the specific host manufacturer"(claim 1), as well as
2) " ***host software file*** associated with a specific host manufacturer and a model associated with the specific host manufacturer. (claim 34).

Thus, in various claims, either a "host" and/or a "host software file" can be "associated with a specific host manufacturer and a model associated with the specific host manufacturer."

Applicant is **not required** to include all the narrowing limitations disclosed in the specification in each claim. Indeed, a claim is not required to recite all the features of an embodiment of the invention. In claim 23, applicant has chosen to recite "a host software file"

without adding further limitations thereto. *This does not by itself render the claim invalid under 35 U.S.C. 112, paragraph 2.*

Rather, in claim 23, Applicant has chosen to limit the *host* as being "associated with a specific host manufacturer and a model of the specific host manufacturer." This is clearly supported in the specification (see, e.g., paragraph 103), and recited in other claims (see, e.g., claim 1.

Thus, the Applicant has chosen in different claims to variously recite that the "*host software file*" or the "*host*" being further limited by being "associated with a specific host manufacturer and a model associated with the specific host manufacturer." Consequently, the wording in claim 23 was the intent of the Applicant, and should not be rejected as invalid.

Applicant has amended claim 23 to recite a "wherein" clause, which was missing, and this perhaps may have contributed to the Examiner's confusion regarding the text of claim 23.

Consequently, it is argued that rejection under 35 U.S.C. 112 is improper for claim 23, and that the rejection be withdrawn. Further, the rejection involving dependent claims 24-29 should also be withdrawn.

CONCLUSION

Applicant has:

1) Provided reasons why the rejection for claim 23 should be withdrawn;

2) Provided a terminal disclaimer to overcome the rejection for claim 41;

3) Rewritten claims 34-36 to overcome the objection; and

4) Cancelled claims 31-33, 37-40, and 49-57.

Applicant submits that the remaining claims in a condition for allowance. Should there be any matters which preclude the issuing of a notice of allowance, the Examiner is encouraged to contact the attorney of record at (404) 881-4748 to resolve any minor issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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